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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/236, 402 05/02/94 DEAN

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EXAMINER

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HM22/0620

MINNIFIELD, N

ART UNIT	PAPER NUMBER
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1645

37

DATE MAILED:

06/20/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No. 08/236,402

App. Unit(s)

DEAN ET AL

Examiner

N. M. Minnifield

Art Unit

1645



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on \_\_\_\_\_

2a)  This action is FINAL. 2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle* 1035 C.D. 11; 453 O.G. 213.

### Disposition of Claims

4)  Claim(s) 1-3, 5, 6, 10, 18-21, 24, and 34-37 is/are pending in the application

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-3, 5, 6, 10, 18-21, 24, and 34-37 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.

2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

15)  Notice of References Cited (PTO-892)

18)  Interview Summary (PTO-413) Paper No(s). 36

16)  Notice of Draftsperson's Patent Drawing Review (PTO-948)

19)  Notice of Informal Patent Application (PTO-152)

17)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

20)  Other: \_\_\_\_\_

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## DETAILED ACTION

1. Claims 1-3, 5, 6, 10, 18-21, 24 and 34-37 are now pending in the present application.
2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3, 5, 6, 10, 18-21, 24 and 34-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 5225180.

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Claims 1-3, 5, 6, 10, 18-21, 24 and 34-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6107459.

Claims 1-3, 5, 6, 10, 18-21, 24 and 34-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 and 20-27 of U.S. Patent No. 5552525.

Claims 1-3, 5, 6, 10, 18-21, 24 and 34-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13, 17, 25 and 26 of U.S. Patent No. 6019958.

Claims 1-3, 5, 6, 10, 18-21, 24 and 34-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 5811394.

Claims 1-3, 5, 6, 10, 18-21, 24 and 34-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 5736122.

Claims 1-3, 5, 6, 10, 18-21, 24 and 34-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 7-10 and 12 of U.S. Patent No. 5807538.

Claims 1-3, 5, 6, 10, 18-21, 24 and 34-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 5807537.

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Claims 1-3, 5, 6, 10, 18-21, 24 and 34-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 5780007.

Claims 1-3, 5, 6, 10, 18-21, 24 and 34-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 5788960.

Claims 1-3, 5, 6, 10, 18-21, 24 and 34-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 6074627.

Claims 1-3, 5, 6, 10, 18-21, 24 and 34-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 5997845.

Claims 1-3, 5, 6, 10, 18-21, 24 and 34-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-27 of U.S. Patent No. 6086849.

Claims 1-3, 5, 6, 10, 18-21, 24 and 34-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19, 24-29 of U.S. Patent No. 5997844.

Claims 1-3, 5, 6, 10, 18-21, 24 and 34-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 and 12-16 of U.S. Patent No. 5866097.

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Claims 1-3, 5, 6, 10, 18-21, 24 and 34-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 5989519.

Claims 1-3, 5, 6, 10, 18-21, 24 and 34-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 and 7-9 of U.S. Patent No. 5968476.

Claims 1-3, 5, 6, 10, 18-21, 24 and 34-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 5965107.

Claims 1-3, 5, 6, 10, 18-21, 24 and 34-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 and 8-12 of U.S. Patent No. 5849260.

Claims 1-3, 5, 6, 10, 18-21, 24 and 34-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 and 5-12 of U.S. Patent No. 5879658.

Claims 1-3, 5, 6, 10, 18-21, 24 and 34-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 and 6-10 of U.S. Patent No. 5888474.

Claims 1-3, 5, 6, 10, 18-21, 24 and 34-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6017510.

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Claims 1-3, 5, 6, 10, 18-21, 24 and 34-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 5654272.

Claims 1-3, 5, 6, 10, 18-21, 24 and 34-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 and 17-22 of U.S. Patent No. 5561220.

Claims 1-3, 5, 6, 10, 18-21, 24 and 34-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 and 34-39 of U.S. Patent No. 5925331.

Claims 1-3, 5, 6, 10, 18-21, 24 and 34-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 5508020.

Claims 1-3, 5, 6, 10, 18-21, 24 and 34-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16, 24-28 and 30 of U.S. Patent No. 5951964.

Claims 1-3, 5, 6, 10, 18-21, 24 and 34-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5443815.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both the application and patent claim a product (agent, reagent, compound, composition, imaging agent, or peptide reagent) comprising polyvalent linker, specific-binding peptide(s) and a technetium-99

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binding moiety; wherein the specific-binding peptide(s) and the technetium-99 binding moiety are covalently linked to the polyvalent linker.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

3. No claims are allowed.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to N. M. Minnifield whose telephone number is (703) 305-3394. The examiner can normally be reached on Monday-Thursday from 7:00 AM-4:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette R. F. Smith, can be reached on (703) 308-3909. The fax phone number for Technology Center 1600 is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

  
NITA MINNIFIELD  
PRIMARY EXAMINER

N. M. Minnifield

May 23, 2001

  
NITA MINNIFIELD  
PRIMARY EXAMINER